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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,680	05/26/2000	Blake R. Pepinsky	BIIJ-P02-067	8259

28120 7590 04/23/2003

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BOSTON, MA 02110-2624

EXAMINER
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O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 04/23/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/579,680	PEPINSKY ET AL.
	Examiner Eileen O'Hara	Art Unit 1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 January 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) See Continuation Sheet is/are pending in the application.

4a) Of the above claim(s) 19,22-27,34,35,39,47,49,60,61 and 90-92 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10, 14, 15, 28-31, 40-42, 46, 48, 50, 53, 56, 57, 63-68, 71, 87-89 and 93-110 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

Continuation of Disposition of Claims: Claims pending in the application are 1-10,14,15,19,22-32,34,39-42,46-50,53,56,57,60,61,63-68,71 and 87-110.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-10,14,15,19,22-32,34,39-42,46-50,53,56,57,60,61,63-68,71 and 87-110.

**DETAILED ACTION**

1. Claims 1-10, 14, 15, 19, 22-32, 34, 39-42, 46-50, 53, 56, 57, 60, 61, 63-68, 71 and 87-110 are pending in the instant application. Claims 1, 28-30, 40, 50, 53, 56, 66, 67, 71, 87, 89 and 93 have been amended and claims 105-110 have been added as requested by Applicant in Paper Number 20, filed January 29, 2003.

Claims 19, 22-27, 34, 35, 39, 47, 49, 60, 61 and 90-92 are withdrawn as being drawn to a non-elected invention.

Claims 1-10, 14, 15, 28-31, 40-42, 46, 48, 50, 53, 56, 57, 63-68, 71, 87-89 and 93-110 are currently under examination.

***Priority***

2. Applicants' amendment to the specification to recite the priority to the provisional applications claimed in the declaration is acknowledged.

***Withdrawn Rejections***

3. Any rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

***Double Patenting***

4. Claims 1-10, 14, 15, 28-31, 40-42, 46, 48, 50, 53, 57, 63-68, 71, 87-89 and 93-104 remain rejected, and new claims 105-110 are rejected, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 6, 10-18, 41-46, 48, 74, 77-79, 85 and 94-97 (now claims 1-27) of U. S. Patent No. 6,444,793. Although the conflicting

claims are not identical, they are not patentably distinct from each other because they are both drawn to hydrophobically modified hedgehog proteins.

5. This application contains claims 19, 22-27, 34, 35, 39, 47, 49, 60, 61 and 90-92 drawn to an invention nonelected with traverse in Paper No. 13. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Conclusion***

6. No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1646

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

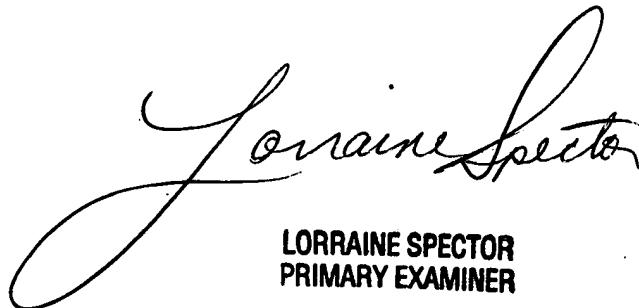
Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner

A handwritten signature in black ink, appearing to read "Lorraine Spector".

LORRAINE SPECTOR  
PRIMARY EXAMINER